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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1947.

No 241

SAMUEL O. BLANC,

Petitioner,

vs.

SPARTAN TOOL COMPANY,

Respondent.

**PETITION FOR WRIT OF CERTIORARI AND
BRIEF IN SUPPORT THEREOF**

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SPARTAN TOOL COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associated Justices of the Supreme Court of the United States:

Your petitioner, Samuel O. Blanc, prays that a writ of certiorari should issue to review the judgment of the United States Circuit Court of Appeals for the Seventh Circuit entered May 27, 1948 (Rec. p. 556) in the above entitled cause.

A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved

This is a suit brought by petitioner against respondent for infringement of petitioner's patent Re. No. 22,113, issued July 16, 1942, and based on original patent No. 2,-

111,527, dated March 15, 1938, and petitioner's patent No. 2,069,871, issued February 9, 1937. Reissue patent No. 22,113 relates to a sewer cleaning machine embodying a helically wound flexible coil spring as one of its essential elements which is capable of being wound to a high tension, the same being insertable into a length of drain or sewer pipe for removing roots, debris, and obstructions of various types from the sewer. The machine is also provided with a cutting tool, preferably of the type disclosed in patent No. 2,069,871, which is attached to the free end of the flexible coil spring, the other end of the flexible coil spring being attached to and supported by a storage means in the form of a reel, either of the external or internal type which, when rotated, imparts to the flexible coil spring a rotary motion about its longitudinal axis for rotating and spinning the cutter attached at the free end thereof. The arrangement of the reel and its driving connection to the motion imparting means, as well as the arrangement of the reel to the anti-kinking device and guide for the flexible coil spring at the forward end of the machine, is such that the flexible coil spring may be readily manipulated without damaging the machine and without endangering the operator during the operation of the machine, and particularly when high torque is built up in the flexible coil spring.

The entirely new concept of petitioner's machine resides in the fact that in order to cleanly cut roots and other debris from the inner surface of a sewer or tile, it is necessary to build up a high degree of torque within the mechanical spring which, when released, causes the cutter to rapidly spin. Petitioner's inventive concept contemplates a particular arrangement of the guide and anti-kinking device with respect to the reel so as to provide an effective drive for rotating the flexible spring coil and to provide for the control and manipulation thereof even

when wound to high tension, in which condition it becomes a highly dangerous instrumentality in that the same has a decided tendency to kink and to become uncontrollable.

Cutters made in accordance with patent No. 2,069,871 embody five essential characteristics, described more in detail hereafter, which make them particularly suitable for use as an element of said machine where high torque is built up in the flexible coil spring for cutting roots and the like from sewers.

For the convenience of this Court, Reissue patent No. 22,113 will hereinafter be referred to as the "Machine Patent" and patent No. 2,069,871 as the "Cutter Patent."

The District Court for the Northern District of Illinois, Eastern Division, held claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent invalid for lack of invention over the prior art, and not infringed by respondent, and claims 3 and 6 of the Cutter Patent invalid for lack of invention over the prior art, and not infringed by respondent (Rec. p. 296).

The Court of Appeals for the Seventh Circuit affirmed the judgment of the District Court with respect to invalidity and non-infringement of the specified claims of both the Machine and Cutter Patents (Rec. p. 556).

This petition is directed to a review of the decision of the Court of Appeals with respect to the holding of invalidity and non-infringement of the Machine and Cutter Patents.

Jurisdiction.

1. This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24(7) (28 U. S. C., Sec. 41 (7)).

2. The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C., Sec. 347).

3. The date of the judgment which petitioner seeks to have reviewed is May 27, 1948 (Rec. p. 556).

Questions Presented.

The decision of the Circuit Court of Appeals for the Seventh Circuit presents the following questions:

1. Whether the conflict between the decision of the Circuit Court of Appeals for the Seventh Circuit in this cause, and the decision of the Circuit Court of Appeals for the Sixth Circuit with respect to the validity of the patents in suit should be resolved in the interest of uniformity of decisions in the various Circuit Courts of Appeals throughout the United States.

2. Whether the conflict between the decision of the Circuit Court of Appeals for the Seventh Circuit in this cause, and the decisions of the Circuit Courts of Appeals for the Sixth and Eighth Circuits and the District Courts within the Eighth Circuit, with respect to the scope and interpretation of the patents in suit, should be resolved in order that the public at large may be properly advised as to what devices and mechanisms constitute infringements of the patents in issue.

3. Whether the Circuit Court of Appeals for the Seventh Circuit properly held that the claims of the Machine and Cutter Patents in issue are invalid as lacking invention, and that respondent's machine and cutters do not infringe said claims.

4. Whether in an ordinary patent suit, as in the instant case, where the suit was instituted and prosecuted in good faith, and the record is absolutely devoid of any showing of fraud or dilatory practices on the part of petitioner or that respondent has been subjected to harassment or unfair, oppressive or vexatious litigation, a District Court is justified in assessing attorneys' fees against

petitioner under the general provisions of Revised Statutes, 35 U. S. C. A. Sec. 70.

5. Where it is unlikely and highly improbable that Circuit Courts of Appeals will review and interpret the general provisions of Revised Statutes, 35 U. S. C. A., Sec. 70 (with the possibility of ultimate conflict of decisions), with respect to when the assessment of attorneys' fees is proper, because of the discretionary powers reposing in the District Courts (the decision of the Circuit Court of Appeals for the Seventh Circuit in this case probably being typical of such Courts' unwillingness to ascertain the determinative facts with respect to whether the assessment of attorneys' fees in any case is justified), whether the conflict between the decision of the District Court for the Northern District of Illinois, Eastern Division, in this cause, and the decisions of the District Courts of the Third and Sixth Circuits, with respect to the interpretation and application of Revised Statutes, 35 U. S. C. A., Section 70, as it applies to the assessment of attorneys' fees in any particular case, should now be resolved and said Statute construed by this Court in the interest of the public and the uniform application and administration of federal justice.

Reasons for Granting the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds:

(1) The Court of Appeals for the Seventh Circuit has held claims 4, 5, 7, 8, 9, 10 and 11 of petitioner's Machine Patent invalid, whereas the Court of Appeals for the Sixth Circuit, in the earlier cases of *Blanc v. Curtis*, 119 F. 2d 395, and *Blanc v. Cayo*, 139 F. 2d 695, held claim 4 of petitioner's Machine Patent valid. In the former case, claim 4 was the only claim involved, while in the latter case, the Court of Appeals expressly overruled the trial

court's decision in holding claim 4 invalid as being in contravention to the decision in *Blanc v. Curtis*, 119 F. 2d 395, and decided the case with respect to claims 5, 7, 8, 9, 10 and 11 also in issue, solely upon the ground of non-infringement. Under similar circumstances, certiorari was granted by this Court in *Ensten v. Simon, Ascher & Company, Inc.*, 282 U. S. 445, *Smith, Administratrix v. Springdale Amusement Park, Limited, et al.*, 283 U. S. 121, *Permutit Co. v. Graver Corporation*, 284 U. S. 52, and *Electric Cable Joint Co. v. Brooklyn Edison Co., Inc.*, 292 U. S. 69.

(2) The Court of Appeals for the Seventh Circuit held claims 4, 5, 7, 8, 9, 10 and 11 of petitioner's Machine Patent in suit, not infringed by respondent's machine, whereas the Court of Appeals for the Sixth Circuit in the earlier case of *Blanc v. Curtis*, 119 F. 2d 395, in considering claim 4 of the original of the Reissue Machine Patent, evaluated petitioner's contribution in the art, and in construing said claim 4 then in issue, ascribed to petitioner's invention the very device complained of in this cause. The District Court for the Southern District of Iowa, Southern Division, in the case of *Blanc v. Longstaff* and *Blanc v. Smith*, 58 U. S. P. Q. 54, recognized the precedent established by the decision in *Blanc v. Curtis*, 119 F. 2d 395, and held petitioner's Machine and Cutter Patents valid and infringed by the defendants, Longstaff and Smith, the defendant Longstaff's machine being in all essentials identical with respondent's machine in this case.

(3) The Court of Appeals for the Seventh Circuit has held claims 3 and 6 of petitioner's Cutter Patent in suit invalid as lacking invention over the prior art, whereas the Court of Appeals for the Sixth Circuit in the earlier case of *Blanc v. Curtis*, 119 F. 2d 395, held claims 3 and 6 of this patent valid and construed the patent as disclosing a meritorious invention which substantially ad-

vanced the art. It further held that the patent was entitled to a liberal construction. In deciding the case of *Blanc v. Curtis*, 119 F. 2d 395, the Court of Appeals for the Sixth Circuit emphasized that its decision with respect to the patents was in conformity with the decisions reached by the District Court for the Southern District of Iowa, Southern Division, in the cases of *Blanc v. Weston*, 33 U. S. P. Q. 466, *Blanc v. Weston*, 35 U. S. P. Q. 150, and *Blanc v. Weston*, 42 U. S. P. Q. 427. The decision of the Court of Appeals for the Eighth Circuit in the case of *Blanc v. Weston*, 109 F. 2d 911, with respect to the scope and interpretation of the claims of petitioner's Cutter Patent is not inconsistent with the decision in *Blanc v. Curtis*, 119 F. 2d 395, but is in conflict with the decision of the Court of Appeals for the Seventh Circuit in this cause.

In its holding, the Court of Appeals in the case of *Blanc v. Curtis*, 119 F. 2d 395, held the cutters manufactured and sold by the defendant Curtis, which are in their essentials indistinguishable from respondent's cutters in the present case, to constitute infringements of claims 3 and 6 of petitioner's Cutter Patent.

(4) That an important question of federal law which has not been settled, but should be settled by this Court, is presented by the decision of the District Court and the Court of Appeals for the Seventh Circuit in this case, in allowing respondent attorney's fees, where the record fails to show that the case is other than an ordinary patent case and that there are any special circumstances of gross injustice prejudicial to respondent's interests and position. The assessment of attorney's fees under Revised Statutes, 35 U. S. C. A., Section 70, being a discretionary matter not reviewable by Circuit Courts of Appeals in the absence of abuse, it becomes necessary for this Court at the present time to define and interpret this Section

of the Statutes to resolve the conflict existing between the decision of the District Court in this case and the decisions in *Juniper Mills, Inc., v. J. W. Landenberger & Co.*, 76 U. S. P. Q. 300 (D. C., E. D., Penn.), *National Brass Co. v. Michigan Hardware Co.*, 75 F. Supp. 140 (D. C., W. D., Mich., S. D.), and *Lincoln Electric Co. v. Linde Air Products Co.*, 74 F. Supp. 293 (D. C., N. D. Ohio E. D.), in the interest of uniformity and consistency in the decisions with respect to this question and in order that an authoritative precedent may be established for all Circuits throughout the United States.

Wherefore, it is respectfully submitted that a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit should be granted.

GORDON F. HOOK,
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The findings and conclusions of the United States District Court for the Northern District of Illinois, Eastern Division, were filed June 19, 1947 (Rec. p. 283) and the judgment entered pursuant thereto on June 26, 1947 (Rec. p. 306).

The opinion of the Circuit Court of Appeals for the Seventh Circuit was filed May 27, 1948 (Rec. p. 548). It is reported in 168 F. 2d 296.

Jurisdiction.

Note petition (*supra*, p. 3).

Statement of the Case.

The essential facts of the case are stated in the accompanying petition for writ of *certiorari*.

Specification of Errors.

The errors which petitioner will urge if a writ of *certiorari* is issued are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. In holding that claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent are invalid, and not infringed by respondent's sewer cleaning machine.
2. In holding that claims 3 and 6 of the Cutter Patent are invalid, and not infringed by respondent's cutters.
3. In approving the District Court's finding that attorneys' fees should be assessed against petitioner in this case.

ARGUMENT.

Validity of Machine and Cutter Patents Sustained.

The validity of the original and Reissue Machine Patent, as well as the Cutter Patent, has been sustained by the Court of Appeals for the Sixth Circuit in its prior decisions in *Blanc v. Curtis*, 119 F. 2d 395 and *Blanc v. Cayo*, 139 F. 2d 695, the Court of Appeals for the Eighth Circuit in *Blanc v. Weston*, 109 F. 2d 911, and the District Court for the Southern District of Iowa, Southern Division, in 58 U.S.P.Q. 54, 42 U.S.P.Q. 427, 35 U.S.P.Q. 150 and 33 U.S.P.Q. 466. Prior to the present decision, both patents have been sustained with the exception of the case of *Blanc v. Cayo*, 50 F. Supp. 552, in which the District Court for the Western District of Michigan, Southern Division, held claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent, and claims 1 to 6 of the Cutter Patent invalid in view of the prior art, and not infringed by the defendant Cayo. In that case on appeal (139 F. 2d 695), the Court of Appeals for the Sixth Circuit expressly reversed the trial court with respect to its holding of invalidity of claim 4 and decided the case with respect to all of the claims of both patents in issue on the predicate of non-infringement.

Such findings, on the authority of *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U. S. 275, 278, *Williams Co., v. United Shoe Machinery Corp.*, 316 U. S. 364, 367, and others, should not be disturbed by this Court and the issues herein should be limited to the determination of infringement of the patents involved.

Machine Patent.

The petitioner, Blanc, through the inventions of the patents in suit, was the first to disclose to the art the

combination of a machine and cutter (Machine Patent, claim 11) in which high torque could be built up within the flexible spring element, which could be safely manipulated and controlled and which, as one of its essential characteristics, operates on the principle of releasing such torque for rapidly rotating the cutter for effectively cleaning the interior surface of sewers, drains and the like. The machine and cutters of the two patents involved are of novel construction and possess recognized practical and commercial merit.

The sewer cleaning machine of the Machine Patent in suit differs from all other machines of the prior art in that the same embodies a combination of elements which cooperate and co-act in a manner entirely foreign and distinct to anything suggested in the prior art for the cleaning of such sewers and drains. Whereas, for the most part, the prior art machines were confined to structure capable of operating merely to ram or dislodge the stoppage in sewers and the like, petitioner's Machine Patent has the novel characteristic of being able, not only to accomplish such functions, but also to operate in the manner described to assure cleaning of the sewer at the inside surface thereof. Petitioner's patented machine and its principle of operation are not disclosed or even suggested in the prior art.

The Circuit Court of Appeals for the Sixth Circuit, in the case of *Blanc v. Curtis*, 119 F. 2d. 395, recognized petitioner's contribution in the art and, while it was of the opinion that the various elements of the combination were not new, nevertheless, it ascribed invention to petitioner's sewer cleaning machine.

After pointing out that the flexible shaft of petitioner's machine was the same as the flexible element of the Stremel patent No. 1,616,833 (119 F. 2d. 396) it discussed, among others, the three principal patents to Yohn, Nos.

2,037,103 and 2,037,104 and Kugelman No. 2,042,407, and concluded that invention was involved with the following remarks:

"The amount of power stored in Blanc's spring coil is very high and the working out of a device which would control this amount of power and at the same time fulfill the other needs of the work to be done in the ordinary house sewer required more than mechanical skill. We conclude that claim 4 is valid."

The decision of the Circuit Court of Appeals for the Sixth Circuit affirmed the opinion of the Patent Office that invention was involved in allowing the claims in the original and reissue applications over these prior art patents.

The Circuit Court of Appeals for the Sixth Circuit in its decision in *Blanc v. Cayo*, 139 F. 2d 695, specifically reaffirmed its holding of validity of claim 4 and, accordingly, it must have agreed that petitioner's Machine Patent discloses inventive ingenuity, as expressed in its prior decision in *Blanc v. Curtis*.

The Circuit Court of Appeals for the Seventh Circuit in the present case, premised its holding of invalidity of the claims of the Machine Patent on the theory that the elements of petitioner's machine were old and that the same function no differently than corresponding elements in the prior art. It made reference to the disclosure of flexible shafts (Rec. p. 552) in patents of the prior art, comparable in all respects to the Stremel patent No. 1,616,833 referred to for the same purpose by the Circuit Court of Appeals for the Sixth Circuit in deciding the case of *Blanc v. Curtis*. The Court of Appeals then proceeded to give its interpretation of three prior art patents which it considered to fully anticipate petitioner's contribution in the art, and on which it rested its conclusion that no invention was involved. These are the Yohn

patents Nos. 2,037,103, 2,037,104 and the Kugelman patent No. 2,042,407. These patents were reviewed by the Court of Appeals for the Sixth Circuit in the case of *Blanc v. Curtis*, but that court held that the same were not anticipatory and concluded that petitioner's contribution amounted to inventive ingenuity. The Court of Appeals in this case concluded its opinion with respect to the invalidity of petitioner's Machine Patent with the following remarks:

"To us it appears that all the elements of 113 were old in the art and functioned no differently in plaintiff's patent than they did in the prior art. Bringing together of old devices, without securing some new and useful result as the joint product of the combination, does not constitute a patentable invention, *Adams v. Bellaire Stamping Co.*, 141 U.S. 539, and when no new function results from a combination of elements and the new result is merely that which arises from the operation of each one of the elements, the arrangement does not constitute invention. 'There is merely an "aggregate of old results."' *General Machinery Corp. v. Clearing Machine Corp.*, 99 F. 2d 20, 27. See also *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549; *McIlvaine Patent Corp. v. Walgreen Co.*, 138 F. 2d 177; and *Allen-Bradley Co. v. Square D. Co.*, F. 2d, decided by this court on March 6, 1948."

Thus, it will be seen that the decisions of the Court of Appeals for the Sixth Circuit and the decision of the Court of Appeals for the Seventh Circuit in this cause, are irreconcilable and in complete conflict with one another, not only from the standpoint of the conclusions reached, but the premises and reasoning advanced in support of such conclusions.

The specific embodiment of petitioner's invention is shown in the patent (Rec. p. 336). From the drawings and description, it clearly appears that the machine comprises an elongated flexible element 49 of coiled spring

wire which is capable of being inserted to any length in a sewer pipe, and when the end thereof is held against rotation by the cutter 56 engaging roots and the like, of being wound to high tension; a reel 28 for holding and storing the flexible spring element; guide means 20, 21 on the axis of rotation of the reel through which the flexible spring element passes when it is fed onto and off of the reel; a motor 57 for imparting rotational movement to the reel and to the flexible spring element; and an anti-kinking device in the form of a tubular member 35 which imparts a crank-like formation to that portion of the flexible spring element lying between the reel and the guide, and which maintains its crank-like formation against kinking under conditions of high tension so that at all times during the operation of the device, the flexible spring element may be turned by the crank and thereby be wound up to create the high tension required for the cutting of roots and the like. This tension when released functions to exert a high and quickly applied force to the root cutter 56 which is mounted on the inner end of the flexible spring element, with the result that roots and the like are quickly and effectively removed from the sewer.

The action of the flexible coil spring is more particularly described in the patent (Rec. p. 338, (p. 2 of Patent), lines 49 to 59, col. 2).

It will be noted that the specific illustrative form of the invention of petitioner's Machine Patent embodies a reel of the external type, that is to say, one in which the flexible spring element is stored upon the outside of the reel in contradistinction to a reel of the internal type in which the flexible spring element is stored within the confines of the reel. The question as to whether these two forms of reels are mechanical equivalents in the combination of the Machine Patent, was first raised for judicial determination before the Court of Appeals for the

Sixth Circuit in the case of *Blanc v. Curtis*, 119 F. 2d 395. That court held that such reels are equivalents in the combination, and stated (p. 397):

“In appellees’ machine (Patent 1,963,561, issued to Sanger), the shaft is coiled inside an annular space within the periphery of the drum or reel rather than wound on a hub in the usual manner. Appellant’s commercial embodiment of the patent also uses an internal reel rather than the external reel shown in the drawings and we regard the difference between the reels as immaterial.”

Claim 4 of petitioner’s Machine Patent was the only claim then in issue and in view of the above, that court necessarily decided that claim 4 is not limited to a machine in which an external type of reel is employed, and ascribed to petitioner’s invention, as defined by said claim, a device embodying an internal type of reel.

It is further apparent from that decision (p. 397) that while the court was unwilling to interpret the claim as being infringed by the device then in issue (exemplified in the Sanger patent No. 2,167,268, (Rec. p. 496)), because of what it considered to be a material difference in the anti-kinking devices employed, nevertheless, it is apparent from the decision that the court did not intend that claim 4 should be limited to exclude those devices in which a tubular anti-kinking device forms a part of the assembly.

In arriving at the decision in the case of *Blanc v. Curtis*, the Court of Appeals had occasion to refer to the decision of the District Court for the Southern District of Iowa, Southern Division, in the case of *Blanc v. Weston*, 42 U.S.P.Q. 427, in which claim 4 of the Machine Patent was similarly construed.

In the later cases of *Blanc v. Longstaff* and *Blanc v. Smith*, 58 U.S.P.Q. 54, the same District Court in recog-

nizing the precedent established by the Court of Appeals for the Sixth Circuit in *Blanc v. Curtis*, with respect to claim 4, held the defendants' devices to infringe claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent.

The structure of respondent's sewer cleaning machine can be best determined from the physical machine itself, Defendant's Exhibit A, and the cut (Rec. p. 247) appearing as Defendant's Exhibit W-1 and, as constructed, contains all of the novel characteristics of the invention of the Machine Patent, and fully responds in every respect to the definition which the Circuit Court of Appeals for the Sixth Circuit in the case of *Blanc v. Curtis*, gave to the Blanc invention.

Respondent's machine employs a flexible spring element in which the unused portion is held by a reel of the internal type and is rotated by a motor which drives the reel. The flexible spring element passes through a tubular member having a guide portion on the axis of rotation of the reel for controlling the flexible spring element while the same is payed out from and retracted into the reel. The tubular member which integrally embodies the guide at the front of the machine is adapted to rotate with, or relative to, the reel, and serves as a means for preventing kinking of the flexible spring element when high torque is wound into the same and manipulated to cut roots and the like in sewers. The tubular member also disposes the flexible spring element in crank-like formation with respect to the reel and its axis of rotation, whereby the same may be rotated about its longitudinal axis for rotating the cutter and for winding torque into the flexible spring element.

The operation of respondent's machine is described in respondent's bulletin (Rec. pp. 203-206).

Of the seven claims in issue, claims 4 and 11 may be

taken as typical, it being noted that claim 10 sets forth the identical structure of claim 11 except for the incorporation of the cutter which constitutes an element of the combination of claim 11. It will be observed that respondent's device responds literally and in spirit to the terms of said claims. The device incorporates an internal type of reel which the Court of Appeals for the Sixth Circuit in the case of *Blanc v. Curtis* held to be equivalent to the external type of reel of the specific embodiment of the invention disclosed in petitioner's patent. Respondent's machine also includes a tubular anti-kinking device which, in combination with the other elements as arranged in respondent's machine was ascribed by that court as constituting petitioner's invention, as defined in claim 4 of the Machine Patent.

It is to be observed that the Circuit Court of Appeals for the Seventh Circuit in this case decided the issue of validity adversely to petitioner and merely affirmed the judgment of the District Court with respect to infringement without comment. Finding of Fact 16 (Rec. p. 291) is to the effect that in a sewer cleaning machine as disclosed by petitioner's Machine Patent, reels of the internal and external type are not equivalents. Finding of Fact 15 (Rec. p. 290) is to the effect that the tubular member of respondent's device is not the equivalent of, and does not function to perform the same results as, the anti-kinking tubular element of the patented structure.

Such findings of fact are incompatible with the findings of the Circuit Court of Appeals for the Sixth Circuit in the case of *Blanc v. Curtis*, and the Circuit Court of Appeals for the Seventh Circuit, in affirming the District Court in this case, has brought about a conflict with respect to infringement of petitioner's Machine Patent which requires clarification by this Court.

Cutter Patent.

The invention of this patent relates to a specially designed and constructed cutter which is capable of functioning as the cutter element attached to the end of the flexible spring element of a sewer cleaning machine made in accordance with the invention of the Machine Patent.

The cutter of the patent (Rec. p. 332) comprises a head adapted to be attached to the flexible spring element at one end, and has blades attached to the other end for cutting roots and removing debris from sewers and the like. The assembly is characterized as embodying the following essential features, namely—

(a) The blades must diverge outwardly from the mounting hub;

(b) The blades must be capable of flexing inwardly and outwardly in such manner that they may be pressed together so as to enter and pass through small restrictions in pipes, such as encountered at inlet openings and at joints and bends therein, and when once inside to again expand to their original positions;

(c) The blades must have rearwardly inclined cutting edges and be capable of exerting a holding action with respect to an obstruction for stopping the end of the flexible spring element to cause the same to wind up to create the required high tension therein, and at the same time exert a draw cutting action to sever roots and the like when the spring tension is released and high rotary motion is imparted to the cutter;

(d) The leading ends of the cutter must be turned inwardly to produce a sled-runner action in sliding over and passing restrictions and bends in the pipe; and

(e) The blades must have such flexibility as to be capable of responding to centrifugal force produced by the high speed rotary motion created when the high-tension

sion spring is released, so as to be expanded by such force to a maximum divergence and to thereby engage the inner surface of the pipe or sewer, irrespective of the size thereof, and to cut the roots or other debris flush with the pipe surface, with the result that the pipe is entirely freed of all obstructions.

The action of the cutter is described in the specification of the patent (Rec. p. 334 (p. 2 of Patent), lines 6 to 19, Col. 1).

Petitioner's Cutter Patent was held valid by the Court of Appeals for the Sixth Circuit in the case of *Blanc v. Curtis*, 119 F. 2d 395, and was recognized as covering a pioneer implement and entitled to be liberally construed. It was therein stated (p. 339):

"Appellant's cutter is a pioneer implement, and should be given a construction sufficiently broad to realize the purpose of the patent. It is a meritorious improvement, substantially advancing the art, and is entitled to a liberal construction. *National Battery Co. v. Richardson Co.*, 6 Cir., 63 F. 2d 289, 293. Appellant's and appellees' cutters are substantially identical, operating on the same principle and accomplishing the same result in substantially the same way. *Cf. Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 50 S. Ct. 9, 74 L. Ed. 147; *Sun Ray Gas Corp. v. Bellows-Claude Neon Co.*, 6 Cir., 49 F. 2d 886. The use of a knife practically identical with one of the accused cutters was held in *Blanc v. Weston*, 35 U.S.P.Q. 150, to violate the injunction issued in *Blanc v. Weston*, 33 U.S.P.Q. 466."

The scope and interpretation given to claims 3 and 6 by the Court of Appeals in holding the same valid and infringed by appellees' cutters in the case of *Blanc v. Curtis*, conforms in all respects to that of the District Court for the Southern District of Iowa, Southern Division, in the cases of *Blanc v. Weston*, 33 U.S.P.Q. 466,

and *Blanc v. Weston*, 35 U.S.P.Q. 150, referred to and acquiesced in by the Court of Appeals in deciding that case.

As with respect to the Machine Patent, the case of *Blanc v. Curtis* established a precedent which was followed in the cases of *Blanc v. Smith* and *Blanc v. Longstaff*, 58 U.S.P.Q. 54, wherein the District Court for the Southern District of Iowa, Southern Division reiterated its position with respect to the Cutter Patent in holding claims 1 to 6, inclusive, valid and infringed by the defendants therein.

In contrast to the interpretation given claims 3 and 6 of the Cutter Patent by the Court of Appeals for the Sixth Circuit in *Blanc v. Curtis*, the Circuit Court of Appeals for the Seventh Circuit in this case, held the identical claims invalid on the ground that no invention was involved in combining those elements which it considered to be old in the art on the theory that no new function was performed by the device.

Respondent's cutters (Def. Exs. B-1 to B-4) are fairly represented and their operation described in respondent's bulletin (Plf. Ex. I, Rec. p. 203) and, as will be apparent, possess all of the peculiar characteristics and special features above enumerated which identify petitioner's contribution in the art. Such cutters are designed to be introduced through a small opening of a pipe, and then expand to the diameter of the larger tile under the action of centrifugal force, and finally engage roots and other debris, exert the holding action requisite for winding high tension in the flexible spring element (where such action is necessary) and chop or cut roots or other debris flush with the tile wall when the high tension is released.

While respondent's cutters are formed with blades in opposed relation to one another, this, however, was consid-

ered immaterial by the Court of Appeals for the Sixth Circuit in the case of *Blanc v. Curtis*, 119 F. 2d 395, in conformity with the broad interpretation placed upon claims 3 and 6 then in issue.

The court therein stated (p. 399):

"In view of the construction that we give this patent we do not consider these variations material, nor that the rearward inclination of the blades as distinguished from that of the cutting edges is the gist of appellant's invention. We agree with the Court of Appeals for the Eighth Circuit (*Blanc v. Weston*, 109 F. 2d 911, 912) that an essential characteristic of the *Blanc* cutter patent is a thin flexible cutting member of very high resilience. * * *

Similar cutters were held to be infringements of claims 3 and 6 in the case of *Blanc v. Curtis*. The cutters held to infringe in that case are reproduced in this record, pages 212 to 216, inclusive.

While the Circuit Court of Appeals for the Seventh Circuit decided the issues with respect to the Cutter Patent solely on the ground of invalidity thereof, it affirmed the judgment of the District Court in its finding that respondent did not infringe on the basis that respondent's cutters did not embody the essential elements above recited which characterize petitioner's contribution in the art.

The situation as it involves petitioner's Cutter Patent is similar in all respects to the Machine Patent, namely, irreconcilable conflict with respect to both validity and infringement between the decision of the Circuit Court of Appeals for the Sixth Circuit as expressed in the case of *Blanc v. Curtis* and the decision of the Circuit Court of Appeals for the Seventh Circuit in this case. Similar conflict with respect to the Cutter Patent exists between the decision in this case and the decisions of the District

Court for the Southern District of Iowa, Southern Division, in the cases above cited, which are clearly in conformity with the decision in the case of *Blanc v. Curtis*. The situation is such that it is necessary for this Court to review the Cutter Patent, and that the questions with respect to validity and infringement be resolved in order that there may be a determinative evaluation of this patent in the interest of uniformity of decisions of the Circuit Court of Appeals throughout the United States.

Attorneys' Fees.

The Revised Statutes, 35 U.S.C.A., Sec. 70, as amended, provides that

“A court may in its discretion award reasonable attorneys' fees to the prevailing party upon entry of judgment in any patent case.”

At the time of entry of judgment by the District Court in this case, no Federal Court had rendered a decision interpreting this amended Statute and indicating under what circumstances attorneys' fees should be assessed against the losing party in a patent suit. The intent of the Statute is explicit, as set forth in the Senate Report No. 1503, June 14, 1946, U.S. Code Congressional Service, 79th Congress, Second Session, 1946, that recovery of attorneys' fees will not become an ordinary thing in patent suits. The District Court indicated very clearly (Rec. pp. 303, 305) at the time of entry of the judgment, that this question as to whether or not this was a proper case in which to assess attorneys' fees should be raised in the Court of Appeals. The record shows that such question was in effect certified to the Court of Appeals for determination.

The Circuit Court of Appeals for the Seventh Circuit (Rec. p. 555) however, refused to review the point in question as intended by the District Court, and held that

the District Court did not abuse its discretionary power in awarding attorneys' fees in this case.

The record clearly shows this to be an ordinary patent case. There is not an iota of evidence to show that there are any special circumstances which would warrant the assessment of attorneys' fees. The record is entirely devoid of any showing that petitioner is guilty of fraud, malice, dilatory practices or vexatious acts in this case; they are entirely absent. Clearly, extended litigation involving petitioner's patents does not constitute special circumstances warranting the assessment of attorneys' fees in this case.

Since entry of the judgment, at least three United States District Courts in patent cases on the order of the present case have refused to assess attorneys' fees against the losing party. See *Lincoln Electric Co. v. Linde Air Products Co.*, 74 F. Supp. 293, *National Brass Company v. Michigan Hardware Company*, 75 F. Supp. 140; *Juniper Mills, Inc., v. J. W. Landenberger & Co.*, 76 U.S.P.Q. 300.

The decision of the District Court in this case with respect to attorneys' fees, which the Circuit Court of Appeals for the Seventh Circuit refused to review, even though the question was certified to it for decision, is in clear conflict with the decisions of other District Courts in the Second and Third Circuits.

It is unlikely and highly improbable that Circuit Courts of Appeals will review and interpret the general provisions of Revised Statutes, 35 U.S.C.A., Sec. 70 (with the possibility of ultimate conflict of decisions) with respect to when the assessment of attorneys' fees is proper because of the discretionary powers reposing in the District Courts. Thus, there is an important question of federal law which has not been settled, but should be settled

now by this Court in the interest of uniformity in the decisions of the Courts of the Federal Judicial Circuits.

For the reasons above stated, it is urged that the petition for writ of certiorari be granted.

Respectfully submitted,

GORDON F. HOOK,

Counsel for Petitioner.

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CHARLES CLARK GROUP
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1948.

SAMUEL O. BLANC,

Petitioner,

VS.

SPARTAN TOOL COMPANY,

Respondent.

No. 241

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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**BRIEF OF RESPONDENT IN OPPOSITION TO
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May It Please the Court:

The grounds relied on by petitioner for a grant of a writ of certiorari by this Court are (1) alleged conflict between the Courts of Appeals for the Seventh and Sixth Circuits, and (2) approval by the Court of Appeals for the Seventh Circuit of the allowance by the District Court pursuant to 35 U. S. C., Section 70, of attorneys' fees to be awarded to the prevailing party.

The respondent contends that there is no genuine conflict in decision between the circuits as to either patent in suit, and that the allowance of attorneys' fees, not yet fixed in amount, pursuant to the cited statute is likewise no ground for the granting of the petition.

RESTATEMENT OF THE FACTS.

No Conflict Exists Between Courts of Appeals as to Infringement of Either Blanc Patent.—The Courts of Appeals for the Sixth and Seventh Circuits are in full agreement with respect to petitioner's lack of right to injunctive relief against the manufacture and sale of standard commercial machines alleged to infringe Blanc patent Re. 22,113. In the latest case to arise in the Sixth Circuit, namely, *Blanc v. Cayo*,* 139 F. 2d 695, the Court of Appeals held claims 4, 5, 7, 8, 9, 10 and 11 of the Blanc machine patent Re. 22,113 to be not infringed by the defendant's machine. The same result, with respect to the same claims of the same patent, was reached by the Court of Appeals for the Seventh Circuit in the instant case with respect to respondent's machine. Cayo's and respondent's machines are substantially identical, as appears from a comparison of the photograph and drawing of Cayo's machine taken from the *Cayo* record, appended at the end of this Brief and marked "Cayo's Machine," with the reproduction of a photograph of respondent's machine (Defendant's Exhibit W-1) appearing at page 247 of the record, also attached at the end of this Brief and marked "Respondent's Machine."

Both Cayo's and respondent's machines comprise, essentially, a flexible shaft, or plumber's snake, colored yellow, coiled in a motor driven cage or container, colored blue, rotatably mounted on a frame, one end of the shaft being led out along the axis of rotation of the container through an anti-kicking or distributor tube, colored red. Cayo's container for the flexible shaft is in the form of

*A copy of the record in the *Cayo* case is in evidence in the instant case as a physical exhibit marked Plaintiff's Exhibit XX.

a slightly tapered cage, whereas defendant's container has no taper and its walls are solid. No difference in operation or function results from this slight variation in the form of the container. Both of these machines have similar parts functioning in the same manner to produce the same results.

In the earlier decision of *Blanc v. Curtis*, 119 F. 2d 395, the Court of Appeals for the Sixth Circuit held that claim 4 of the original Blanc machine patent, No. 2,111,527, which is the same as claim 4 of the reissue patent, was not infringed by Curtis' machine.

No court of appeals has ever held either the original or the reissue patent to be infringed by any commercial machine. The courts of appeals are unanimous in the view that equitable relief should be denied to the petitioner because the claims both of the original and of the reissue patent are too narrow to read on present day commercial machines such as respondent's or Cayo's.

In *Blanc v. Cayo* in the District Court (50 F. Supp. 552, 557), Judge Raymond held claims 4, 5, 7, 8, 9, 10 and 11* of the reissue patent, to be invalid, as well as not infringed. On appeal (139 F. 2d 695) Judge Raymond's decision was affirmed in all respects save as to the invalidity of claim 4. No reason was given in the opinion for this exception, save that the claim had previously been held valid although not infringed in *Blanc v. Curtis*, 119 F. 2d 395. No difference in operation or result exists between claim 4 called valid, and the other claims, to-wit, 5, 7, 8, 9, 10 and 11, held invalid in *Blanc v. Cayo*.

*These same claims were in suit in the instant case and were held invalid and not infringed in both the District Court and in the Court of Appeals.

There is likewise no conflict between courts of appeals on the question of noninfringement of the claims of the Blanc cutter patent by cutters such as those manufactured and sold by this respondent, as illustrated on the drawing, Defendant's Exhibit Y, appearing at page 252 of the record. Figure 2 of this exhibit, showing defendant's cutter, compared with Figure 2 of the drawing of Blanc's patent, clearly discloses the essential difference between the two cutters. Blanc's blades, in the language of claim 3, are "inclined rearwardly relative to their direction of rotation," and respondent's are not, but are exactly opposite each other and in the same plane as their direction of rotation.

In the earlier Sixth Circuit decision of *Blanc v. Curtis*, 119 F. 2d 395, the Court of Appeals had held that the claims of the cutter patent were infringed by Curtis' blades even though they were not "rearwardly" inclined as specified in Blanc's claims. This view, however, was repudiated by the same court in the later case of *Blanc v. Cayo*, 139 F. 2d 695, where the defendant's blades, like respondent's, were not rearwardly inclined. The District Court had held that on account of this lack of rearward inclination, Cayo's blades did not infringe any of the claims of the Blanc cutter patent. In affirming, the Court of Appeals held (139 F. 2d 695, at 696) that "The conclusion reached by the District Court that none of the six claims of the cutter blades in suit are infringed by the cutter blades of appellee's structure *was obviously correct*,"* thus overruling the court's earlier expressed view in *Blanc v. Curtis*. The same conclusion as to noninfringement of the cutter patent was reached in *Blanc v. Weston* in the Eighth Circuit, 109 F. 2d 911, where the Court of

*Emphasis ours.

Appeals affirmed the lower court's ruling that the blades of the defendant's structure, having no rearward inclination, did not infringe the claims of that patent. Thus, in spite of some preliminary fumbblings by the district courts in the Eighth Circuit, the Court of Appeals for that circuit is in entire agreement with the Courts of Appeals for the Sixth and Seventh Circuits in holding that no blades made without rearward inclination infringe the claims of the cutter patent.

All the Elements of Blanc's Machine Patent Are Present in the Prior Art and Function Therein Precisely as in the Patent in Suit.—The petition states (p. 2) that "The entirely new concept of petitioner's machine resides in the fact that in order to cleanly cut roots and other debris from the inner surface of a sewer or tile, it is necessary to build up a high degree of torque within the mechanical spring which, when released, causes the cutter to rapidly spin." There is here an admission of the fact, which the record fully supports, that the prior art disclosed cutting blades mounted on the end of mechanical springs which cut roots in sewers upon the release of torque. Petitioner merely claims that his machine builds up a higher degree of torque than prior machines. In the Patent Office prosecution of the application for his patent, Blanc made the same admission. He said (Rec. p. 222):

"It is true that plumber's snakes when in use will engage an obstruction and be held against rotation and that some tortional strains will be built up therein when the other end is further rotated and that when released some added speed and force will be applied to the cutter. *This was generally known prior to applicant's invention.*" Applicant's inventive

*Emphasis ours.

thought is based on the fact which he has so successfully demonstrated in extensive commercial use that in order to obtain the amount of such torsional strain necessary for cleanly cutting off large roots, the flexible shaft must be twisted to such an extent that there is also produced within the flexible shaft a tendency to kink the shaft."

Thus, petitioner concedes that his claim to invention rests wholly on making prior art machines stronger and capable of doing heavier work. Patentability cannot depend on such a mere difference in degree.

The petitioner also states (p. 2) that his "inventive concept contemplates a particular arrangement of the guide and anti-kinking device with respect to the reel * * *." There is no such "particular arrangement." As the Court of Appeals for the Seventh Circuit held (Rec. p. 553) every element of the Blanc reissue patent is present in the prior art and performs there in combination precisely the same function as in the patent in suit.

The device of the reissue or "machine" patent comprises a reel 28 mounted on a frame, a flexible shaft 49 wound on the reel and with one end secured thereto at 50, the other end being led out through an anti-kinking tube 38-39 through a hub 20 and a flexible guide member 21. As the motor driven reel is rotated, the flexible shaft, with a cutting device at its free end, is fed into the sewer by means of the guide member 21.

Precisely these parts,* performing precisely as in Blanc's machine patent, are found in the prior art patents

*The prior art discloses reels (Wrigley 599,089, Rec. p. 364; Haines 1,842,166, Rec. p. 422) and containers (Kugelman 2,042,407, Rec. p. 488; Yohn 2,037,103, Rec. p. 474) for storing the flexible shaft. Therefore, patentability cannot rest in the choice of one storage means over the other.

to Kugelman 2,042,407 (Rec. p. 488), Yohn 2,037,103 (Rec. p. 474), and Yohn 2,037,104 (Rec. p. 482). These machines are not motor driven but motor drive is disclosed in Biermann 225,391 (Rec. p. 519) and Silberger 1,898,503 (Rec. p. 430).

Kugelman's flexible shaft 1 is wound in a container 3, and is led out through the anti-kinking device 7 and the guide 10. Rotation of the container revolves the flexible shaft and builds up torque in it should the cleaning tool become arrested by an obstruction in the sewer. If the handle 23 is used to rotate the container, torque will not pass beyond the screw 24; if, however, the screw is not tightened and the container is rotated with the palm of the hand, torque is stored throughout the length of the shaft. No function or element of Blanc's reissue patent is lacking in Kugelman save for the unpatentable detail of securing one end of the shaft to the container, and this is disclosed in other prior art patents, as for instance, in Yohn 2,037,103 (Rec. p. 474). This patent shows a flexible shaft or plumber's "snake" 20 coiled in a container with one end secured thereto at 24, the free end, to which the cleaning tool is attached, being led out through the anti-kinking device 26 and the guide 40.

Yohn 2,037,104 (Rec. p. 482) shows a flexible spring or snake coiled in a container with one end led out through the combined anti-kink and guide tube 6 and 6a.

In Yohn '103 the axis of rotation of the snake is perpendicular to that of the container, whereas in Blanc's machine patent, and in Kugelman, and in Yohn '104 these axes coincide. No difference in operation or function results from this difference in arrangement (Rec. pp. 100-1).

The petition is wholly silent as to what "particular arrangement" of parts and functions is present in peti-

tioner's machine which is not present in these prior art patents. Every element and every function is present, and operates, precisely in Blanc as in the prior art.

The Elements of Blanc's Cutter Patent Are Likewise All Found in the Prior Art and Function Therein Precisely as in the Patent in Suit.—The claims in suit (3 and 6) of Blanc patent 2,069,871 call for a cutter having flexible blades with incurved outer ends to avoid their catching in offset portions of the sewer, the blades, as stated in claim 3, being "inclined rearwardly relative to their direction of rotation" and having their cutting edges further rearwardly inclined. The claims also call for blades of "thin and flexible material," and claim 6 calls for the ends of the blades being turned inward to give the so-called "sled runner" effect in riding over offset portions in the sewer.

The prior art is full of cutters having all these characteristics, even assuming that they might be patentable.

The "rearward" inclination of the blades is the element which, after rejection (Rec. p. 229), carried them to allowance (Rec. pp. 231, 237). This feature is supposed to give them a "draw cutting effect" in use (claim 6). But every boy who ever whittled a stick gets this "effect" with an ordinary pocket knife, and it is also disclosed in many prior art sewer cutters.

The Stevenson patent No. 1,163,624 has "rearwardly inclined" blades, and says of them (Rec. p. 391, pat. p. 1, lines 85-96):

" * * * The blades have thick backs, and their inner faces are beveled abruptly from the backs to the cutting edges as illustrated at C. We have discovered that this form of blade is very effective in not only cutting the grease from the sewer wall but in causing

it to break up into fragments, *the curved form of the blade, and the fact that it is inclined or angularly positioned with reference to the plane of rotation, causing it to cut with a shearing action** and also to break up the released portions."

The so-called "sled runner effect," besides being very obvious, is disclosed in many prior art patents, and is specifically mentioned in Hughes 584,508 (Rec. p. 357, pat. p. 1, lines 53-7), where it is said:

"An important advantage is secured by curving the free ends of the blades toward each other — namely, the tool can more readily be inserted, and in pushing it forward it will freely pass by the joints of the pipe or sewer."

Claim 3 of Blanc says that the cutting edges of the blades are still "further inclined rearwardly." So are the cutting edges of every boy's pocket knife and almost every other kind of knife since time immemorial, and so, specifically, are the cutting edges of the sewer cleaning knives of Hughes 584,508 (Rec. p. 356), La Motte 1,915,679 (Rec. p. 436) and Bolla 267,388 (Rec. p. 529).

In sewer cleaning knives the feature of having the blades themselves "rearwardly inclined" with respect to their direction of rotation is wholly unnecessary. Neither respondent's blades nor Cayo's, in the Sixth Circuit, had any such rearward inclination. Respondent and Cayo *chop* off the roots; they do not *slice* them off.

Blanc is estopped to contend that blades like respondent's and Cayo's, having no rearward inclination, infringe his claims. In the prosecution of his application, Blanc first asserted claims not limited to a rearward inclination of the blades (Rec. p. 228), and these claims were rejected

*Emphasis ours.

on Mulliner 1,211,212 (Rec. p. 229) whose blades, like respondent's and Cayo's were not "rearwardly inclined" (Rec. p. 396). Blanc then amended his claims by inserting the limitation requiring the rearward inclination, and they were thereupon allowed (Rec. p. 230). Obviously, the claims, thus limited, cannot be read on respondent's or Cayo's blades, which are in this respect like Mulliner's, and the courts both in the Sixth and Seventh Circuits have so held. A similar holding appears in the opinion of the Court of Appeals for the Eighth Circuit in *Blanc v. Weston*, 109 F. 2d 911.

ARGUMENT.

(1) **There Is No Genuine Conflict Between the Circuit Courts of Appeals as to Either Blanc Patent.**—All the courts of appeals which have considered the Blanc patents are agreed that the machine patent (Re. 22,113) is not infringed by Spartan's machine in the Seventh Circuit, or by Cayo's almost identical machine in the Sixth Circuit, and all are likewise in agreement that no cutters such as respondent's, lacking the rearward inclination of the blades, infringe the claims of Blanc's cutter patent No. 2,069,871.

The Sixth Circuit Court of Appeals was unduly merciful to Blanc in allowing validity of claim 4 of the machine patent in *Blanc v. Curtis*, 119 F. 2d 395, and in *Blanc v. Cayo*, 139 F. 2d 695, the reaffirmation of this view seems to have been on the ground of consistency rather than accuracy. But however that may be, the important fact on this petition is that the unanimous opinion of every court of appeals is that the claims of the Blanc machine patent do not reach a typical modern sewer cleaning device such as Curtis', Cayo's, or respondent's, and that the claims of the cutter patent do not reach cutters such as respondent's, Cayo's or Weston's. Thus, essentially, there is no basic conflict between the circuits. The decisions of the courts have freed the industry from any threat from either patent in the manufacture and sale of standard sewer cutting machines and cutters therefor as exemplified in respondent's or Cayo's structures. Hence, it is of no consequence that

there is lacking complete unanimity of judicial opinion on the moot question of the validity of claim 4 of the machine patent.

In *Layne & Bowler Corporation v. Western Well Works, Inc., et al.*, 261 U. S. 387, in dismissing a writ of certiorari in a somewhat similar case, this Court said (pp. 392-3):

“It is manifest from this review of the conclusions in the two circuits as to the validity of the Layne patent and the proper construction to be put upon the 9th, 13th and 20th claims, that they were really in harmony and not in conflict and that there was no ground for our allowing the writ of certiorari to add to an already burdened docket. If it be suggested that as much effort and time as we have given to the consideration of the alleged conflict would have enabled us to dispose of the case before us on the merits, the answer is that it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head.”

We submit that the view as to the validity of one claim of the machine patent, expressed as dictum in the opinions of the Sixth Circuit Court of Appeals does not constitute such a “real and embarrassing conflict of opinion and authority” as to justify the issuance of the extraordinary writ of certiorari when there is complete agreement that standard commercial machines and cutters such as respondent’s and Cayo’s do not infringe any claim of either patent.

(2) **The Allowance of Attorneys' Fees as Authorized by Statute is No Ground for the Granting of the Petition.**—The Court of Appeals for the Seventh Circuit approved the District Court's allowance of reasonable attorneys' fees to the successful party; but no award of fees has yet been made. The Court held (Rec. p. 555) that "Under 35 U. S. C. A. §70 the court may in its discretion award reasonable attorneys' fees to the prevailing party," and that until it should appear that as a matter of law there was a clear abuse of discretion, the matter was ended. Until the amount of the fees is determined, there is nothing for any court to pass upon, the power to make the award having been expressly conferred by the statute, and there being no conflict between courts of appeals as to the meaning of the statute.* It has been held many times that the writ of certiorari will not be granted in order to permit the writing of an advisory opinion upon the propriety or validity of statutes (*Muskrat v. United States*, 219 U. S. 346).

In addition to the reasons for denying the petition heretofore given, we submit also that this is a situation where the invalidity of all the claims in suit of both patents, and specifically the invalidity of claim 4 of the reissue patent, is as apparent now as it would be on final hearing should the petition be granted, and that, in consequence, a great saving of the time of this Court and of expense to the parties may be had by a denial of the petition.

*Thus, in *Bianchi v. Barili*, 78 U. S. P. Q. 5, June 15, 1948, the Court of Appeals for the Ninth Circuit held (p. 12) that the award of attorneys' fees under the statute in patent cases was discretionary.

CONCLUSION.

It would seem to be a waste of this Court's time, to say nothing of the serious expense to the respondent, to determine the purely abstract question of the validity of one claim in a patent which nobody uses; and the matter of the award of attorneys' fees is merely a question of statutory interpretation on which no present conflict exists between the circuits, and on which this Court should not be asked to write an advisory opinion. The petition for certiorari should be denied.

Respectfully submitted,

ARTHUR A. OLSON,
THORLEY VON HOLST,
Counsel for Respondent.

CAYO'S MACHINE





RESPONDENT'S MACHINE

DEFENDANT'S EXHIBIT W-1

247



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RESPONDENT'S MACHINE

DEFENDANT'S EXHIBIT W-2

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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1948.

No. 241

SAMUEL O. BLANC,

Petitioner,

vs.

SPARTAN TOOL COMPANY,

Respondent.

Petition for Rehearing.

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IN THE
Supreme Court of the United States

OCTOBER TERM, 1948.

No. 241

SAMUEL O. BLANC,

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vs.

SPARTAN TOOL COMPANY,

Respondent.

PETITION FOR REHEARING.

On October 25, 1948 this Court denied the petition for writ of certiorari filed by the petitioner herein on August 23, 1948 to review the judgment of the Seventh Circuit Court of Appeals affirming the judgment of the District Court in holding certain claims of petitioner's patents Nos. Re. 22,113 and 2,069,871 invalid and not infringed in direct conflict with decisions of the Circuit Court of Appeals for the Sixth Circuit in the cases of *Blanc v. Curtis*, 119 F. 2d 395 and *Blanc v. Cayo*, 139 F. 2d 695.

In view of the denial of this petition, it is evident that the petition apparently failed in clearly and precisely presenting the true situation, namely, an actual, real and embarrassing conflict of opinion and authority with respect to validity and infringement of the Blanc patents between the Circuit Court of Appeals for the Sixth Circuit in the above mentioned cases and the Circuit Court of Appeals for the Seventh Circuit in this case (168 F. 2d 296).

The refusal of this Court to resolve these conflicting decisions of the Sixth and Seventh Circuit Courts of Appeal will result in great and unwarranted injustice to the petitioner and will cause the general public undue hardship and uncertainty. Final adjudication of the Blanc patents with respect to validity and infringement by this Court is necessary to do justice in this case.

For example, in the case of *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350, 352, in which the writ was granted to review conflicting decisions in the Second and Sixth Circuits, this Court stated:

“In the interest of plaintiff seeking to uphold the patent *prima facie* valid, and of the public, liable to exclusion from manufacture, use, or sale in virtue of the right it purports to confer, final adjudication as to validity is of primary importance.”

The questions presented and the reasons why this Court should grant petitioner's writ have been set forth in the original petition at pages 4 to 8, inclusive, and the Court will not be burdened with a repetition of the points which have been urged as being sufficient to warrant this Court in reviewing the lower court's decision. It will be clear by reference to the opinions in the cases of *Blanc v. Curtis*, 119 F. 2d 395, and *Blanc v. Cayo*, 139 F. 2d 695, that the question of validity of the Blanc patents before the Circuit Court of Appeals for the Sixth Circuit was not “moot”, or that the opinion expressed by that Court with respect to validity was not “dictum”, as so erroneously urged by the respondent in its brief in opposition to the petition for writ of certiorari, pages 11 and 12 thereof. Contrary to respondent's contention, there is a genuine, real and embarrassing conflict involving the Blanc patents which should be resolved by this Court in the interests of

justice and the uniformity of decisions in the Sixth and Seventh Circuits.

This Court has consistently recognized such conflicts as grounds for the grant of petitions for writs of certiorari.

As was stated by this Court in the case of *Layne & Bowler Corporation v. Western Well Works, Inc., et al.*, 261 U. S. 387, 393:

“ * * * it is very important that we be consistent in not granting the writ of certiorari *except* in cases involving principles the settlement of which is of importance to the public, as distinguished from that of the parties, and in cases *where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal.*” (Italics ours).

In the case of *Magnum Import Co. v. Coty*, 262 U. S. 159, 163, this Court reiterated the rule as expressed above in the *Layne & Bowler* case as follows:

“The question how the court should exercise this power next arises. The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes, *first to secure uniformity of decision between those courts in the nine circuits*, and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort.” (Italics ours).

In the case of *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319, this Court again stated:

“Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari *unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent.*” (Italic ours).

In the later case of *Standard Brands, Inc. v. National Grain Yeast Corp.*, 308 U. S. 34, 35, this Court, in granting the petition to review conflicting decisions of the Third

and Fourth Circuit Courts of Appeals with respect to a patent stated:

“Irreconcilable views have been approved and we must now decide which is to be preferred.”

The consistency with which this Court has applied the rule for granting petitions for writ of certiorari where there is a real and embarrassing conflict of opinion with respect to the validity and infringement of a patent between Circuit Courts of Appeal is evidenced by a long line of cases, among which are *General Electric Co. v. Jewel Incandescent Lamp Co., et al.*, 326 U. S. 242, 243; *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U. S. 471, 473; *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 320 U. S. 320, 322; *Detrola Radio & Television Corp. v. Hazeltine Corporation*, 313 U. S. 259, 261; *Standard Brands, Inc. v. National Grain Yeast Corp.*, 308 U. S. 34, 35; *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350, 352; *General Electric Co. v. Wabash Appliance Corp., et al.*, 304 U. S. 364, 366; *Textile Machine Works v. Louis Hirsch Textile Machines, Inc.*, 302 U. S. 490, 491; *Mantle Lamp Co. v. Aluminum Products Co.*, 301 U. S. 544, 545; *Essex Razor Blade Corp. v. Gillette Safety Razor Co.*, 299 U. S. 94, 95; *Keystone Driller Co. v. Northwest Engineering Corp.*, 294 U. S. 42, 44; *Smith v. Snow, et al.*, 294 U. S. 1, 3; *Electric Cable Joint Co. v. Brooklyn Edison Co., Inc.*, 292 U. S. 69, 70; *Permutit Co. v. Graver Corporation*, 284 U. S. 53, 54; *Smith, Administratrix, v. Springdale Amusement Park, Limited, et al.*, 283 U. S. 121, 122; *Ensten et al. v. Simon, Ascher & Company, Incorporated*, 282 U. S. 445, 449; and *Sanitary Refrigerator Company v. Winters, et al.*, 280 U. S. 30, 34.

The circumstances under which the petition in these cases was granted are the same as exist in this case. There are no circumstances which would exclude the present case

from the application of the rule so well established by this Court.

It is respectfully requested that the Court grant a rehearing of the petition for writ of certiorari filed herein and set aside its order denying such petition and grant the prayer of the petition for writ of certiorari.

Respectfully submitted,

GORDON F. HOOK,
Counsel for Petitioner.

Certificate of Counsel.

The undersigned, attorney of record for the petitioner, Samuel O. Blanc, hereby certifies that the foregoing petition for rehearing is presented in good faith and not for delay, and is restricted to a presentation of a real and embarrassing conflict of opinion and authority between the Sixth and Seventh Circuit Courts of Appeal with respect to validity and infringement of the Blanc patents involved, a situation apparently overlooked by this Court in its review of the petition for writ of certiorari, which apparent oversight is an intervening circumstance of controlling significance in this case.

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Gordon F. Hook